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| | Art Unit | 2872 | |
| | Examiner Name | Lee A. Fineman | |
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| Remarks - Appeal Brief (9 pages) submitted following Notice of Appeal dated 12/07/2004 | | |
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| Firm Name | | |
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Docket No. CASL01NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Christopher L. Casler

Art Unit: 2872

Filed: 11/28/2000

Examiner: Lee A. Fineman

App. No.: 09/995,933

For: Hemispheric lens for a remote-controlled retail
electronic entertainment device

APPEAL BRIEF UNDER 37 CFR § 41.37

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BEST AVAILABLE COPY Appeal Brief under 37 CFR § 41.37**1. Real party in interest**

The real party in interest is the Applicant, Christopher L. Casler.

2. Related appeals and interferences

There was one other related Appeal to the Board. A Notice of Appeal was filed on 03/28/2001 for the parent application (App. No. 09/468,476 filed 12/21/1999). After subsequent submission of the corresponding Appeal Brief, prosecution of the application was reopened by the Examiner in an Office Action dated 07/19/2001.

There are no other related appeals or interferences known to Applicant or Applicant's Agent.

3. Status of claims

The application was originally filed with Claims 1-16, Claims 1 and 9 being independent claims.

In an amendment accompanying a Request for Continued Examination dated 06/08/2004, Claims 1, 2, 4, 9, 10, and 12 were amended and Claims 3, 5-8, 11, and 13-16 were cancelled.

Claims 1, 2, 4, 9, 10, and 12 were then rejected in an Office Action dated 08/09/2004. Claims 1, 2, 4, 9, 10, and 12 remain pending in the application, stand rejected, and are under appeal. Claims 1 and 9 are independent claims.

4. Status of amendments

No additional amendments have been filed after the amendment of 06/08/2004.

5. Summary of claimed subject matter

The claimed subject matter comprises methods for retrofitting a previously-purchased remote-controlled retail electronic entertainment device for increasing the acceptance angle for an infrared receiver thereof. Independent Claim 1 recites method steps performed by the purchaser of the device, while independent Claim 9 recites method steps performed by a supplier or seller of a lens employed in the methods.

The methods comprise: i) purchasing by or selling to the purchaser (page 9 line 22 through page 10 line 2), subsequent to the purchase of the entertainment device, a hemispheric lens made of transparent dielectric material and having hemispheric convex outer and concave inner surfaces and a flat annular surface therebetween with

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double-sided adhesive tape (Figs. 2-4; page 9, lines 1-13); and iii) securing the lens (by the purchaser, or instructing the purchaser to do so) to the front face of the entertainment device over its remote-control receiver to increase the acceptance angle thereof (page 9 line 22 through page 10 line 2). Each independent claim concludes with a list of specific remote-controlled retail electronic entertainment devices, recited in the alternative, that the independent claims are intended to encompass (page 8, lines 10-16).

While the specification recites that other adhesives may be employed, the claims specifically recite double-sided tape and are specifically limited thereto. While the list of retail electronic entertainment devices in the specification is left open-ended ("and so forth"), the list of such devices recited in the claims is not. The claims are intended to encompass only those retail electronic entertainment devices explicitly recited.

6. Grounds for rejection to be reviewed on appeal

Claims 1, 2, 4, 9, 10, and 12 stand rejected under 35 USC §103(a) as being unpatentable over Keitoku (US 5,036,188) in view of Harwood (GB 1,500,495) and Haddock (US 4,912,880) or Takahashi (US 4,921,330).

Briefly, the Examiner has asserted that: i) Keitoku discloses an audio-visual remote-controlled retail electronic device with hemispheric lens for increasing the acceptance angle; ii) Harwood teaches a hollow hemispheric lens made from acrylic plastic with a flat annular surface secured to a device, and that the lens is retro-fitted; iii) Haddock or Takahashi teach use of double-sided tape for securing the lens; iv) it would have been obvious to combine these teachings; and v) it would have been obvious to purchase or sell the resulting device on a retail basis for installation on a previously-purchased device for increasing the acceptance angle. Applicant respectfully traverses several of these assertions, on the grounds set forth in detail hereinbelow.

Claims 1, 2, 4, 9, 10, and 12 shall stand or fall together on appeal, with independent Claim 1 serving as the primary basis for consideration of this appeal.

7. Arguments

All arguments that follow are presented in traversal of the rejection of Claims 1, 2, 4, 9, 10, and 12 under 35 USC § 103 over Keitoku in view of Harwood and Haddock or Takahashi.

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Examiner states that Keitoku discloses an "audio-visual-remote-controlled-retail electronic device ... as well as a hemispheric lens ... used for increasing the acceptance angle". Applicant does not dispute this assertion. The Examiner goes on to assert that it would have been obvious to modify the device of Keitoku in light of the teachings of the other references to arrive at the claimed invention. Applicant respectfully traverses this assertion, for the following reasons.

Applicant respectfully submits that the very nature of the retail electronic entertainment devices recited in the claims and available at the time the invention was made teaches away from any sort of retro-fitting of the devices, and therefore teaches away from any application of the teachings of the secondary references to modify the device of Keitoku. As is well known to those skilled in the art, the electronic entertainment devices recited in the claims and intended for retail sale have become essentially consumable, disposable products. Devices are manufactured on assembly lines by unskilled labor, and the plastic outer cases (including the front faces) of such devices are usually snap- or press-fit together. The devices are not intended to be reopened, modified, repaired, or retro-fitted in any way, and often cannot be reopened without damaging the device. Applicant therefore respectfully submits that any rejection under 35 USC § 103, based on Keitoku with a teaching of retro-fitting supplied by another reference, is improper.

Examiner specifically cites Harwood to supply the teaching of retrofitting the device by securing a lens to its front face, and using a hemispheric lens with convex outer, concave inner, and flat annular surfaces to do so.

Careful study of Keitoku reveals that every embodiment pictured includes a radial flange on the lens, and clearly shows that the lens was installed from within the outer case of the device. No other manner of installation or attachment is shown or suggested anywhere in Keitoku. Applicant respectfully submits that the disclosure of Keitoku implicitly teaches away from any installation of a hemispheric lens with a flat annular surface secured on the front face of the device. The Examiner has not demonstrated any showing, teaching, or motivation in Keitoku or Harwood for combining the references or indicating the desirability of modifying the lens of Keitoku for mounting with a flat surface on the front face of the device. Applicant therefore respectfully submits that the rejection is improper.

Regarding Harwood, the Examiner asserts that it would have been obvious to "make the lens of Keitoku ... [to] have a substantially hemispheric concave inner and

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concave outer surface ... as suggested by Harwood, to provide cost savings by using reduced amounts of ... materials." Applicant respectfully submits that this assertion is wholly inaccurate. The hemispheric inner and outer surfaces in the claimed invention are chosen so as to achieve the desired increase in acceptance angle for the infrared receiver, not for any cost or material saving. No one skilled in the art would have looked to Harwood for such a teaching or suggestion, since the lens of Harwood is intended to be used underwater, while the lens of the appealed claims is intended to be used in air. As such, the respective optical design or optimization problems are completely different, and one cannot be used as a guide for the other. Applicant therefore respectfully submits that the rejection is improper.

Regarding Harwood, the Examiner states that: "Harwood teaches a hemispheric lens (4) ... having substantially concave inner and convex outer surface [sic] and having a substantially flat annular surface ... which is secured to the device (1)." Applicant respectfully submits that this is an inaccurate characterization of Harwood. Harwood discloses a multi-element wide-angle lens attachment for an underwater camera. The element (1) is not the device (i.e. the camera) to which the lens attachment is secured, but is the housing of the lens attachment itself. The hemispherical lens (4) is secured by its flat annular surface to this housing (1), which is in turn secured to the device (the underwater camera, including elements (2) and (3)), as clearly shown in the Figure of Harwood. The housing and lens elements disclosed in Harwood together form a water-tight, air-spaced lens assembly, which is secured by a sleeve portion of housing (1) to the underwater camera. Such a sleeve would be unsuitable for securing to the front face of a retail electronic entertainment device. Applicant respectfully submits that there is no teaching in Harwood of any hemispheric lens secured directly by its flat annular surface to a previously-purchased device, and that the rejection is therefore improper.

The Examiner goes on to add the teachings of Takahashi or Haddock to those of Harwood and Keitoku, stating that it would have been obvious to use an adhesive, including double-sided tape, to secure the lens assembly of Keitoku/Harwood to a device. Applicant respectfully submits that such a use of adhesive is in fact inconsistent with the teachings of Harwood. Among the stated advantages of Harwood are the abilities to rapidly return the camera to its normal state by removing the lens attachment or swinging it aside while underwater, and to readily extend the focusing range of the camera by securing the lens attachment to the camera (page 1 line 96 through page 2 line 4). Harwood therefore implies that the lens assembly is to be readily and repeatedly removed and replaced on the camera. Modifying the teachings of Harwood

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to include use of an adhesive such as double-sided tape would render the lens assembly unsuitable for one of its stated purposes. Therefore, rejection under 35 USC § 103 is improper (*In re Gordon*, 733 F.2d 900, 221 USPQ 1125).

In view of the above, Applicant respectfully submits that the rejection of Claims 1, 2, 4, 9, 10, and 12 is improper, and respectfully requests that the Board reverse the rejection.

Respectfully submitted,

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8. Claims appendix

All 6 claims still pending in the application are involved in this appeal. The pending claims are:

1. **(previously presented)** A method, performed by a retail purchaser of a previously-purchased remote-controlled retail electronic entertainment device, for retro-fitting said remote-controlled device to provide an increased acceptance angle for an infrared receiver thereof, the method comprising the steps of:
purchasing, on a retail basis and subsequent to a previous purchase of said remote-controlled device, a hemispheric lens, the hemispheric lens comprising a lens body, the lens body being fabricated from a dielectric material substantially transparent at an infrared wavelength received by the infrared receiver, the lens body having a substantially hemispheric convex outer surface, a substantially hemispheric concave inner surface, a substantially flat annular surface connecting the inner and outer hemispheric surfaces, and an adhesive layer comprising double-sided adhesive tape provided on the annular surface for securing the lens to a face of the remote-controlled retail electronic entertainment device over the infrared receiver thereof; and
after purchasing the hemispheric lens, securing the hemispheric lens to the face of the previously-purchased remote-controlled retail electronic entertainment device over the infrared receiver thereof, thereby increasing the acceptance angle over which infrared remote control signals may be received by the infrared receiver,
wherein the remote-controlled retail electronic entertainment device is a television, a video cassette recorder, a video cassette player, a DVD player, a DVD recorder, a cable television receiver, a satellite television receiver, a radio, a stereo, a hi-fi system, an audio cassette player, an audio cassette recorder, an audio CD player, an audio CD recorder, a home theatre system, a surround-sound system, an MP3 player, an MP3 recorder, a DVD-audio player, or a DVD-audio recorder.
2. **(previously presented)** The method of Claim 1, wherein the dielectric material is substantially clear acrylic plastic.

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3. **(cancelled)**
4. **(previously presented)** The method of Claim 2, wherein the lens body has a hemispheric inner surface is about $\frac{3}{8}$ inch in diameter and the lens body hemispheric outer surface is about $\frac{1}{2}$ inch in diameter.
- 5.-8. **(cancelled)**
9. **(previously presented)** A method for enabling a retail purchaser of a previously-purchased remote-controlled retail electronic entertainment device to retro-fit said remote-controlled device to provide an increased acceptance angle for an infrared receiver thereof, the method comprising the steps of:
selling, on a retail basis to the retail purchaser of the previously-purchased remote-controlled retail electronic entertainment device and subsequent to a previous purchase thereof, a hemispheric lens, the hemispheric lens comprising a lens body, the lens body being fabricated from a dielectric material substantially transparent at an infrared wavelength received by the infrared receiver, the lens body having a substantially hemispheric convex outer surface, a substantially hemispheric concave inner surface, a substantially flat annular surface connecting the inner and outer hemispheric surfaces, and an adhesive layer comprising double-sided adhesive tape provided on the annular surface for securing the lens to a face of the remote-controlled retail electronic entertainment device over the infrared receiver thereof; and
instructing the retail purchaser of the previously-purchased remote-controlled retail electronic entertainment device to secure the hemispheric lens to the face of said remote-controlled device over the infrared receiver thereof, thereby increasing the acceptance angle over which infrared remote control signals may be received by the infrared receiver,
wherein the remote-controlled retail electronic entertainment device is a television, a video cassette recorder, a video cassette player, a DVD player, a DVD recorder, a cable television receiver, a satellite television receiver, a radio, a stereo, a hi-fi system, an audio cassette player, an audio cassette recorder, an audio CD player, an audio CD recorder, a home theatre system, a surround-

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sound system, an MP3 player, an MP3 recorder, a DVD-audio player, or a 45 cm diameter MP3 recorder. DVD-audio recorder.

10. **(previously presented)** The method of Claim 9, wherein the dielectric material is substantially clear acrylic plastic.

11. **(cancelled)**

12. **(previously presented)** The method of Claim 10, wherein the lens body hemispheric inner surface is about $\frac{3}{8}$ inch in diameter and the lens body hemispheric outer surface is about $\frac{1}{2}$ inch in diameter.

13.-16. **(cancelled)**

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